

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Duck Chul HWANG et al.

Application No. 09/910,952

Group Art Unit: 1745

Confirmation No. 3638

Filed: July 24, 2001

Examiner: Laura S. Weiner

For: ELECTROLYTE FOR A LITHIUM-SULFUR BATTERY AND A LITHIUM-SULFUR
BATTERY USING THE SAME

PETITION UNDER 37 CFR §1.181

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby respectfully petition from the premature designation of Paper No. 20070903 in the above-identified application as a "Final" Office Action, request withdraw of the designation of "Final" for a complete Office Action and restarting of a period for response. As reasons therefor, Applicants respectfully state the following:

STATEMENT OF FACTS

1. On April 24, 2007, the Examiner issued an Office Action (Paper No. 20070417) rejecting claims 4, 8 – 9, 11 – 13, 29 and 36 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner provided suggestions of subject matter supported by the written description. The Examiner further rejected claims 4, 8 – 14, 16, 17, 29, 31 - 40 and 43 under 35 U.S.C. §112, second paragraph as allegedly being indefinite on the alleged grounds that it is unclear what is meant by "a dielectric constant that is greater than or equal to 20" and on the alleged grounds that it is unclear what is meant by the first solvent having "a polarity high enough to dissolve an ionic compound."
2. On July 23, 2007, Applicants amended claims 4, 11, 12 and 36 according to the Examiner's suggestions and amended claims 11, 12 and 14 to further define the first solvent as having a polarity sufficient to dissolve Li_2S_n ($n = 1, 2, 4, 6, 8$).
3. On September 11, 2007, the Examiner issued a premature "Final" Office Action (Paper No. 20070903) allowing claims 14, 16, 17, 36 – 39 and 43 and rejecting claims 4, 8 – 13, 29, 34 and 35 under a new statutory provision, 35 U.S.C. §102(b) as being anticipated by a different, newly cited prior art, Whitney et al.,

U.S. Patent No. 4,670,363.

REMARKS

MPEP §706.07(a) provides that a second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Further, MPEP §706.07(a) also describes that:

"A second or any subsequent action on the merits in any application...should not be made Final if it includes a rejection, on prior art not of record, of any claims amended to include limitations which should reasonably have been expected to be claimed. See MPEP §904. For example, one would reasonably expect that a rejection under 35 U.S.C. §112 for the reason of incompleteness would be responded to by an amendment supplying the omitted element."

In the present application, the Examiner has clearly introduced a new ground of rejection based upon on a newly cited prior art reference, namely Whitney et al., U.S. Patent No. 4,670,363, in order to support the rejection under 35 U.S.C. §102(b) of claims 4, 8 – 13, 29 and 34 - 35. Under MPEP §706.07(a), the Examiner cannot introduce a new prior art, raise a new ground rejection not necessitated by Applicants' Amendment filed on July 23, 2007, and make that Office Action "Final". In particular, since the amendments provided in the response of July 23, 2007 were directed to subject matter suggested by the Examiner or were presented to predictably address issues of clarity and definiteness, the new ground rejection was not necessitated by Applicants' Amendment filed on July 23, 2007. Moreover, Whitney was applied as allegedly describing a nonaqueous electrolyte and electrochemical cell having an a solvent having a dielectric constant greater than 20, an electrolyte comprising 0.8 LiAsF₆ in 30/70 v/v sulfolane/toluene and that the electrolyte can be used in an Li/FeS₂ cell or a secondary cell comprising a lithium anode and a TiS₂ cathode. Since these features were not added by Applicants' Amendment filed on July 23, 2007, Whitney could have been applied before Applicants' Amendment filed on July 23, 2007, and the new ground of rejection was not necessitated by Applicants' Amendment filed on July 23, 2007.

CONCLUSION


In view of the foregoing facts and explanations, Applicants respectfully request that the Commissioner: (1) withdraw the designation of Paper No. 20070903, mailed on September 11, 2007, as a "Final" Office Action; (2) reissue another Office Action and restart the period for response; and (3) grant such and other relief as justice may require.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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Date: Oct 2, 2007

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